

REMARKS/ARGUMENTS

Applicants would like to thank the examiner for the careful consideration given the present application, and for the personal interview conducted on March 25, 2003. The application has been carefully reviewed in light of the Office action and interview, and this paper is the response thereto.

The rejection of claims 1-3 under 35 U.S.C. §103(a) as being unpatentable over Swail. (U.S. 5,630,224) was maintained. For the following reasons, the rejection is again respectfully traversed.

Claim 1 recites “a battery for supplying power to the radio communication section, the information processing section, and the interface” (lines 11-12). The reference does not teach this element as limited by the claim language.

The Examiner cites Swail as disclosing a radio communication section (102) and an information processing section (105). The Examiner cites battery 205 for supplying power to the radio communication section (102) and an information processing section (105). However, FIG. 2 of Swail does not support the Examiner’s observation. Figure 2 shows a battery 207 and power supply 205 powering Swail’s data transceiver 102, and a *different* battery 209 and power supply 211 powering Swail’s computer 105. See further col. 3, lines 50-60 and col. 4, lines 10-15 & 41-50, which teach using separate power supplies as shown in the figure. Thus, Swail does *not* teach a “battery for supplying power to the radio communication section, the information processing section, and the interface” as maintained by the Examiner.

In reply to the above argument made in a previous response by applicant, the Examiner states in the Office action that applicant’s claim does not recite a “single power supply”. This

statement is irrelevant. Applicant *does* recite that “a battery” supplies power to the “radio communication section” *and* “the information processing section” *and* “the interface”, whereas Swail teaches a *first power supply* powering its data transceiver 102 and a *second power supply* powering its computer 105. There is no battery in Swail providing power to all three parts. This was discussed during the personal interview, where the Examiner was not able to show how Swail taught this element of the claim. The Examiner argued that the limitation was “obvious”, but could show of no motivation in the reference for making the required changes. One skilled in the art would know that the Swail teaching of two separate power supplies powering two separate components does not teach the recited “a battery for supplying power to the radio communication section, the information processing section, and the interface” of claim 1. Therefore Swail does not teach the recited limitation and thus claim 1 is patentable over the reference.

Claim 1 also recites “means for deactivating the information processing section and the interface when the radio communications section is in a *transmission* state” (lines 15-17 emphasis added).

Swail discloses a subscriber terminal with means for deactivating a portable computing device during an “active portion” of an “active time period” (the “active portion” is a subset of the “active time period”, see col. 6, lines 60-65 & col. 7, lines 14-18) and reactivating the portable computing device when the “active portion” is complete (e.g., col. 7, lines 14-24). Swail is concerned with RF *interference* in a radio frequency *receiver* when an attached computing device is operating (see col. 1, lines 43-52; col. 3 lines 16-20, col. 4, lines 42-50; & col. 5, lines 24-27). Accordingly, the “active time period” (and thus “active portion”) in Swail is clearly

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defined as a period for activating an RF *receiver* (see col. 2, lines 22-25; col. 4 lines 4-10; col. 4, lines 65-67; col. 5, lines 8-11 & 12-15; and col. 7, lines 14-24 & 32-35; see also claim 1, lines 28-30)

Nowhere could applicant find any suggestion in Swail for deactivating any component during a *transmission* state, as claimed. In fact, the only discussion found within Swail about transmission clearly defines the “active time period” and/or “active portion” as occurring only *after* a transmission, not “during” as recited in applicant’s claim 1 (see Swail col. 2, lines 30-34 & 47-51; col. 6, lines 60-66; and col. 7, lines 35-40 & 40-44). During the personal interview, the Examiner admitted that Swail teaches going into a “desense” mode only some time period *after* transmission had occurred, referring to the above passages. The Examiner could not show how Swail teaches any desense operation during transmission itself, and, in fact, Swail teaches away from any such operation in the cited passage by stating that desense only occurs some time period after transmission.

Accordingly, applicant could find no support for the teaching cited by the Examiner that the “active portion” includes a transmission operation, and, in fact, Swail explicitly teaches that the “active portion” applies only to the receiver.

In response to applicant’s arguing these points in a previous paper, the Examiner merely states in the Office action that “during the active portion” means that “the transceiver is either transmitting or receiving communication is taking place”, but provides no citation as to where in the reference this teaching is found. During the personal interview, the Examiner could show applicant’s representative no such teaching in the reference. Instead, applicant has shown that Swail teaches that the “active portion” includes only the *receiving* operation, and teaches away

from any suggestion that it includes any transmission operation.

In fact, the Examiner admits as much (and thus providing a contradiction within the Office action) by stating that Swail teaches deactivating the information processing section 105 and the interface 117 when the radio communication section (201 and 203) is in a reception cycle, and that it would have been "obvious" to do the same during the transmission state in order to conserve power and minimize interference.

The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

The Examiner has cited no support for any such suggestion in the reference, and the Examiner provides no references supporting any motivation to modify the reference. A conclusory statement, such as the one provided by the Examiner in the Office action, is not sufficient to show obviousness.

Merely listing an advantage of the combination or calling the modification "obvious", with nothing more, is clearly *not* sufficient to establish a prima facie case, as some rationale for combining the references or making the modification must be found in the references (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the *prior art*. (MPEP §2142, last paragraph). In

fact, because Swail is only concerned with radio interference occurring during reception, when weaker signals are involved, there would be no reason to modify Swail according to the invention, because it would not address the problem that Swail is attempting to resolve.

Further, the prior art reference(s) also must teach or suggest *all* of the claim elements and/or claim limitations (MPEP §2143.03). As discussed above, Swail does not teach all of the claim limitations. Accordingly, the rejection for obviousness is improper for lack of motivation, and thus claim 1 is patentable over the reference.

Claims 2-3, being dependent on claim 1, are patentable over the reference for the same reasons discussed above. Further, claim 2 recites means for “controlling the radio communications section and the information processing section so as to exchange information therebetween *only* while the radio communication section is in a *transmission* state. The reference is silent as to the operation of the Swail device during a transmission state, and thus cannot teach this limitation. Accordingly, claim 2 is patentable over the reference.

In addition, claim 3 recites means for “deactivating the information processing section and the interface while the radio communication section is in a voice communication state and information is not input to the information processing section for a given period of time”. Swail is completely silent as to voice communication, and thus does not teach this limitation of claim 3. Further, Swail does not suggest any deactivation of the interface. The Examiner fails to provide any citation in Swail supporting the claim that Swail teaches the limitations of this claim. Accordingly, claim 3 is patentable over the reference.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the

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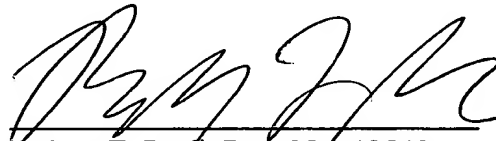
application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 31879.

Respectfully submitted,

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Date: 04-15-2003